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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208141
Party	Plaintiff Goya Foods, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GOYA FOODS, INC.	:	Opposition No.: 91208141
Opposer,	:	
v.	:	
	:	Mark: CASERA
MARQUEZ BROTHERS INTERNATIONAL, INC.	:	Ser. No. 85430918
Applicant.	:	

REPLY TO RESPONSE TO
MOTION TO STRIKE AFFIRMATIVE DEFENSES

In its attempts to narrow issues, Goya recently moved the Board to evaluate sufficiency of Applicant's "affirmative defenses" and strike them accordingly. Instead of relenting, Applicant maintains its defenses are proper and provides case law and rubric that may very well sound good when cut and pasted into a reply, but are incorrect and misleading. As a result, Goya replies as follows,

DEFENSE NO. 1

Applicant suggests it only needs to allege Goya "fails to state a claim upon which relief can be granted" in order for its defense to survive a challenge. *Response* at p. 5. Because Applicant questions sufficiency of its pleading, Goya is allowed to and does move the Board to "utilize this assertion to test the sufficiency of the defense in advance of trial by moving . . . to strike the 'defense' from the defendant's answer." *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, at 1222-1223 (TTAB 1995), *citing S.C. Johnson & Son Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973).

And so, without asking for a ruling on the Opposition - as it appears Applicant envisions – Goya merely asks the Board find the Opposition is properly plead, as more thoroughly stated in its Motion to Strike.

DEFENSE NOS. 2, 3, AND 4

Applicant groups its Response-arguments for Defense Nos. 2 (laches), 3 (waiver), and 4 (estoppel), which can only appear to be a valiant attempt to obscure and confuse.

Applicant argues it provided sufficient notice of its "affirmative defenses" 2, 3, and 4 in view of its fifth and sixth defenses. *Response* at p. 7. Applicant states that the factual allegations "need not be repeated under each affirmative defense heading" so long as the "are already included somewhere in the record." *Id.*

The reasoning is flawed because nowhere in the record or its fifth and sixth affirmative defenses does Applicant allege (1) unreasonable delay and (2) material prejudice – a pleading requirement. *See Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

In realizing it failed to properly plead, Applicant <u>now</u> endeavors to explain (in three pages) basis for its defenses, of which have never been previously alleged. In doing so, not only does Applicant conceal the fact its arguments are newly presented, but asserts to the contrary – that they been there all along. *See Response* at p. 7:

> "Applicant clearly outlined facts in support of its arguments, putting Opposer on fair notice of the factual basis for the defenses of laches, waiver, and estoppel based on the context of Applicant's Answer. The **detail** set out in Applicant's fifth and sixth affirmative defenses is sufficient basis to assert the defenses of laches, estoppel, and waiver." *Response* at p. 7 (emphasis added).

Applicant is not allowed to use its Response as a vehicle to misconstrue allegations never plead (i.e., its Response cannot be incorporated into its pleading by reference). Goya OBJECTS, in turn, and believes no further reply is necessary. In view of same, the Board should strike Defense Nos. 2 (laches), 3 (waiver), and 4 (estoppel) without ado.

DEFENSE NOS. 5 AND 6

Applicant concludes that *even if* its "fifth and sixth affirmative defenses…do not rise to the level of Affirmative defenses…these defenses should not be stricken because they serve to provide notice of how Applicant plans to defend itself at trial. Issues of likelihood of confusion and priority speak **directly to whether the instant opposition presents a real case or controversy**." *Response* at pp. 7-8 (emphasis added).

In addition to yielding above are not affirmative defenses, Applicant identifies the fifth and sixth "affirmative defenses" as direct challenges to sufficiency of Goya's pleading (i.e., as to whether a real case or controversy exists).

This sort of challenge to pleading sufficiency has already been addressed above in regards to Defense No. 1. As so, Goya prays the Board find it properly alleged its Opposition and in doing so, directly strike the fifth and sixth "affirmative defenses" in kind.

THE *CATCH ALL*

Applicant alleges its defenses should be sustained, regardless of any defect, because Goya can't show prejudice. *Response* pp. 8-9. Goya believes its prayer to narrow and limit issues and thereby serve as a guide in conducting discovery speaks for itself. As stated in 2A Moores Federal Practice paragraph 12.21[3]:

> Although courts are reluctant to grant motions to strike, where a defense is legally insufficient, the motion should be granted in order to save the parties unnecessary expenditure in time and money in preparing for trial."
> *Page 1 of Opposer's Motion to Strike*.

As a final catch all, Applicant asks for permission to amend because "**Opposer expressed no objection** to Applicant's use of similar marks for years, and on information and belief acquiesced to Applicant's prior registrations…." *Response* at p. 9 (emphasis added).

There is however no support for Applicant's catch all argument that "Opposer expressed no objection to Applicant's use of similar marks". In fact, Goya takes this opportunity to expressly OBJECT to Applicant's newly raised arguments and asks the Board not to consider awarding such conduct by allowing leave.

CONCLUSION

Applicant answered Opposition and Goya wishes to proceed without being further compelled to again address derisory matter. The Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *See* Rule 12(f), Fed. R. Civ. P. (2012). Goya prays its motion is granted in all respects.

Dated: February 8, 2013

Respectfully submitted for Opposer,
GOYA FOODS, INC.

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing REPLY was sent to attorneys for Applicant this day by e-mail and first class mail, postage prepaid, to the following address:

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/Jason DeFrancesco/

Dated: February 8, 2013

Jason DeFrancesco